



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,311	09/26/2001	Noriaki Nada	MAT-8187US	1311

7590 06/12/2006

RATNER AND PRESTIA
One Westlakes, Berwyn, Suite 301
P.O. Box 980
Valley Forge, PA 19482-0980

EXAMINER

REFAI, RAMSEY

ART UNIT	PAPER NUMBER
----------	--------------

2152

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,311

Applicant(s)

NADA, NORIAKI

Examiner

Ramsey Refai

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

Responsive to Amendment received on March 15, 2006. Claims 1, 4, 5, 7, 8, 10, 11, and 13-16 have been amended. Claims 1-16 remain pending further examination.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims have been amended to now state that the IP address is a public IP address and that a modem acquires a public IP address...from the server. No support for these claimed limitations has been found in the Applicant's specification.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 7-11, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Ranalli et al (U.S. Patent No. 6,748,057).

5. As per claim 1, Ranalli et al teach an Internet telephone system for making a telephone call through the Internet, comprising:

a) a first telephone set, b) a first modem coupled to the first telephone set for communicating with the Internet, c) a second telephone set, d) a second modem coupled to the second telephone set for communicating with the Internet (**Figure 1**), and

e) a server connected to the Internet for storing a plurality of telephone numbers and a plurality of public IP addresses respectively-corresponding to the plurality of telephone numbers (**column 2, lines 40-44**), wherein said first modem acquires a public IP address corresponding to a telephone number of the second telephone set from the server, when the telephone number of the second telephone set is entered in the first telephone set, and then using the acquired public IP address transmits a connection request to said second modem (**column 1, line 66-column 2, line 55**),

6. As per claim 2, Ranalli et al teach wherein said first modem and said first telephone set include a telephone function (**column 3, line 3, column 9, lines 9-15**).

7. As per claim 3, Ranalli et al teach wherein said first modem communicates with said second modem through a public switching network if not replied from the server (**column 3, line 3**).

8. As per claim 4, Ranalli et al teach The Internet telephone system of claim 1, wherein said first modem communicates with said second modem through a public switching network if the public IP address corresponding to the telephone number of the second telephone set is not received from the server (**column 2, lines 10-12, column 3, line 3**).

9. As per claim 5, Ranalli et al teach The Internet telephone system of claim 1, wherein said first modem communicates with said second modem through a public switching network if not replied from the second modem when making a connection operation to the second modem by obtaining the public IP address corresponding to the telephone number of the second telephone set from the server (**column 2, lines 10-12, column 3, line 3**).

10. As per claim 7, Ranalli et al teach f) a host server of the server, wherein if an IP address stored in the server is a local IP address usable within a specific network, a unique public IP address of the server and the telephone number registered in the server are registered in the host server by relating' to each (column 2, line 55-column 3, line 25, column 7, lines 35-50).

11. Claims 8-11, and 13-16 contain similar limitations as claims 1-5 and 7 above, therefore are rejected under the same rationale.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ranalli et al (U.S. Patent No. 6,748,057) in view of Moon (U.S. Patent No. 5,864,758).

14. As per claims 6 and 12, Ranalli et al fails to teach said first modem stores registration information if not replied from the server after transmitting registration information to the server, and transmits the registration information again to the server to register the registration information in the server when the telephone number is entered in the first telephone set.

15. However, Moon teaches information is stored by the modem and retransmitted from one call-attempt to the next during a communications session (column 8, lines 29 – 35). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Ranalli et al and Moon because Moon's use of a modem storing information and resending information during a call attempt would enhance Ranalli et al's system by allowing a modem to store registration information when an attempt to register at a server fails and resending the registration

information during another call attempt which would save time by needing to acquire the registration information once more.

Response to Arguments

16. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

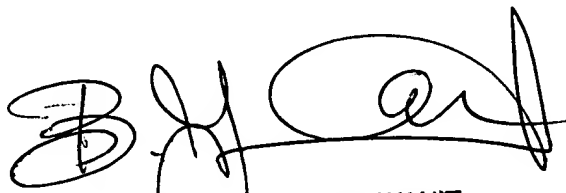
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2152

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ramsey Refai
Examiner
Art Unit 2152
June 6, 2006



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER